

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Brandon YIP et al.

Application No.: 09/403,608

Filed: October 25, 1999

For: COATED SUNGLASS LENS

PCT Legal Office

Leonard E. Smith
Anthony Smith

RENEWED PETITION UNDER 37 CFR 1.48(a)

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Sir:

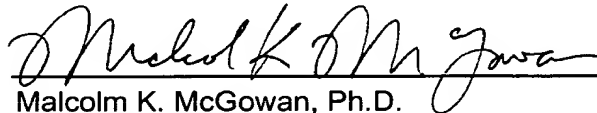
In response to the Decision on Petition Under 37 CFR 1.48(a) issued December 12, 2000 in connection with the above-referenced application, enclosed is a Statement of Assignee Sola International Holdings, Ltd. under 37 CFR 3.73(b) (Form PTO/SB/96), and copies of assignments from the inventors in the above-cited application. Applicants' prior petition (Paper No. was denied on the basis that assignee Sola International Holdings, Ltd had not established its ownership of the application in accordance with 37 CFR 3.73 (see attached copy of Decision on Petition dated 12 December 2000). A copy of Applicants' original Petition, and first Renewed Petition filed October 2, 2000, are also attached.

Favorable reconsideration of Applicants' Petition Under 37 CFR 1.48(a)(1) is
respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:



Malcolm K. McGowan, Ph.D.
Registration No. 39,300

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: March 12, 2001

Attorney's Docket No. 025265-155

STATEMENT UNDER 37 C.F.R. § 3.73(b)

Applicant/Patent Owner: Sola International Holdings Ltd

Application No./Patent No.: 09/403,608

Filed/Issue Date: October 25, 1999

Entitled: COATED SUNGLASS LENS

Sola International Holdings Ltd

(Name of Assignee)

a corporation

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of an undivided part interest

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which copies thereof are attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
2. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
3. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☐ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the PTO. See MPEP 302-302.8]

The undersigned (whose title is supplied below) is empowered to sign this statement on behalf of the assignee.

Date: March 12, 2001


Signature

Malcolm K. McGowan, Reg. #39,300.
Typed or printed name

Ph.D., Esq.
Title

ASSIGNMENT

IN CONSIDERATION of the sum of One Dollar (\$1.00), and other good and valuable
Brandon Yip of Unit 3, 4 Stirling Road, Blackwood, South Australia 5051, Australia;

HEREBY SELL ASSIGN AND TRANSFER to:

Sola International Holdings Ltd of Sheriffs Road, Lonsdale, South Australia, 5160, Australia

its successors, assigns and legal representatives the entire right, title and interest for the United States and all foreign countries, in and to any and all improvements which are disclosed in the application for United States Letters Patent and is entitled

"Coated sunglass lens"

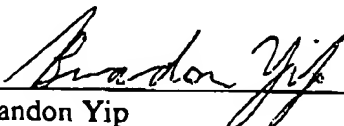
which application was executed by the undersigned on the 5th day of February and in and to any said application and all divisional, continuations, substitute, renewal, reissue, and all other applications for Letters Patent which have been or shall be filed in the United States and in any and all foreign countries on any of said improvements, and in and to all original and reissued patents which have been or shall be issued in the United States and all foreign countries on said improvements and the right to all benefits under the International Convention for the Protection of Industrial Property.

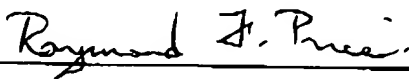
It is hereby authorised and request that the Commissioner of Patents and Trademarks issue any and all said Letters Patent, when granted to said Assignee.

Further it is agreed that when requested, without charge to and at the expense of said Assignee, it successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all said improvements, execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known to the undersigned relating to said improvements and the history thereof; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing and maintaining proper patent protection for said improvements and for vesting title to said improvements and all applications for patents and on all patents on said improvements, in said Assignee, its successors, and legal representatives.

We covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

SIGNED at Adelaide, Australia
this 5th day of February 2001


Brandon Yip


Witness Signature

Name: RAYMOND F. PRICE

ASSIGNMENT

IN CONSIDERATION of the sum of One Dollar (\$1.00), and other good and valuable
Colin James Hall of Unit 2, 8 Hillview Crescent, South Brighton, South Australia 5048,
Australia;

HEREBY SELL ASSIGN AND TRANSFER to:

Sola International Holdings Ltd of Sheriffs Road, Lonsdale, South Australia, 5160, Australia

its successors, assigns and legal representatives the entire right, title and interest for the United
States and all foreign countries, in and to any and all improvements which are disclosed in the
application for United States Letters Patent and is entitled

"Coated sunglass lens"

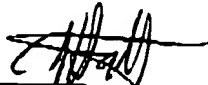
which application was executed by the undersigned on the _____ day of _____ and
in and to any said application and all divisional, continuations, substitute, renewal, reissue, and
all other applications for Letters Patent which have been or shall be filed in the United States and
in any and all foreign countries on any of said improvements, and in and to all original and
reissued patents which have been or shall be issued in the United States and all foreign countries
on said improvements and the right to all benefits under the International Convention for the
Protection of Industrial Property.

It is hereby authorised and request that the Commissioner of Patents and Trademarks issue any
and all said Letters Patent, when granted to said Assignee.

Further it is agreed that when requested, without charge to and at the expense of said Assignee, it
successors, assigns and legal representatives, to carry out in good faith the intent and purpose of
this assignment, the undersigned will execute all divisional, continuing, substitute, renewal,
reissue, and all other patent applications on any and all said improvements, execute all rightful
oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its
successors, assigns and representatives, all facts known to the undersigned relating to said
improvements and the history thereof; and generally do everything possible which said Assignee,
its successors, assigns or representatives shall consider desirable for aiding in securing and
maintaining proper patent protection for said improvements and for vesting title to said
improvements and all applications for patents and on all patents on said improvements, in said
Assignee, its successors, and legal representatives.

We covenant with said Assignee, its successors, assigns and legal representatives that no
assignment, grant, mortgage, license or other agreement affecting the rights and property herein
conveyed has been made to others by the undersigned, and that full right to convey the same as
herein expressed is possessed by the undersigned.

SIGNED at ADELAIDE, AUSTRALIA
this 7th day of February 2001


Colin James Hall


Witness Signature

Name: Joanne Elizabeth Murnin

ASSIGNMENT

IN CONSIDERATION of the sum of One Dollar (\$1.00), and other good and valuable
Frank Arnold Samson of 2632 Cosgrove Road, Strathalbyn, South Australia 5255, Australia;
HEREBY SELL ASSIGN AND TRANSFER to:
Sola International Holdings Ltd of Sheriffs Road, Lonsdale, South Australia, 5160, Australia

its successors, assigns and legal representatives the entire right, title and interest for the United States and all foreign countries, in and to any and all improvements which are disclosed in the application for United States Letters Patent and is entitled

"Coated sunglass lens"

which application was executed by the undersigned on the _____ day of _____ and in and to any said application and all divisional, continuations, substitute, renewal, reissue, and all other applications for Letters Patent which have been or shall be filed in the United States and in any and all foreign countries on any of said improvements, and in and to all original and reissued patents which have been or shall be issued in the United States and all foreign countries on said improvements and the right to all benefits under the International Convention for the Protection of Industrial Property.

It is hereby authorised and request that the Commissioner of Patents and Trademarks issue any and all said Letters Patent, when granted to said Assignee.

Further it is agreed that when requested, without charge to and at the expense of said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all said improvements, execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known to the undersigned relating to said improvements and the history thereof; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing and maintaining proper patent protection for said improvements and for vesting title to said improvements and all applications for patents and on all patents on said improvements, in said Assignee, its successors, and legal representatives.

We covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

SIGNED at Adelaide
this 5th day of February 2001

Frank Arnold Samson
Frank Arnold Samson

Raymond F. Price
Witness Signature

Name: RAYMOND F. PRICE

ASSIGNMENT

IN CONSIDERATION of the sum of One Dollar (\$1.00), and other good and valuable
Brian Douglas Adams of 39 Darwendale Street, Huntfield Heights, South Australia 5163,
Australia;

HEREBY SELL ASSIGN AND TRANSFER to:

Sola International Holdings Ltd of Sheriffs Road, Lonsdale, South Australia, 5160, Australia

its successors, assigns and legal representatives the entire right, title and interest for the United States and all foreign countries, in and to any and all improvements which are disclosed in the application for United States Letters Patent and is entitled

"Coated sunglass lens"


which application was executed by the undersigned on the _____ day of _____ and in and to any said application and all divisional, continuations, substitute, renewal, reissue, and all other applications for Letters Patent which have been or shall be filed in the United States and in any and all foreign countries on any of said improvements, and in and to all original and reissued patents which have been or shall be issued in the United States and all foreign countries on said improvements and the right to all benefits under the International Convention for the Protection of Industrial Property.

It is hereby authorised and request that the Commissioner of Patents and Trademarks issue any and all said Letters Patent, when granted to said Assignee.

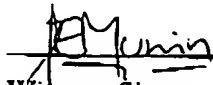
Further it is agreed that when requested, without charge to and at the expense of said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all said improvements, execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known to the undersigned relating to said improvements and the history thereof; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing and maintaining proper patent protection for said improvements and for vesting title to said improvements and all applications for patents and on all patents on said improvements, in said Assignee, its successors, and legal representatives.

We covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

SIGNED at *Lonsdale*
this *2nd* day of *February* 2001



Brian Douglas Adams



Witness Signature

Name: *Joanne Elizabeth Murrin*

ASSIGNMENT

IN CONSIDERATION of the sum of One Dollar (\$1.00), and other good and valuable Randy Lee Gove of 1202 Maple Drive, Rohnert Park, California 94928, United States of America;

HEREBY SELL ASSIGN AND TRANSFER to:

Sola International Holdings Ltd of Sheriffs Road, Lonsdale, South Australia, 5160, Australia

its successors, assigns and legal representatives the entire right, title and interest for the United States and all foreign countries, in and to any and all improvements which are disclosed in the application for United States Letters Patent and is entitled

"Coated sunglass lens"

which application was executed by the undersigned on the _____ day of _____ and in and to any said application and all divisional, continuations, substitute, renewal, reissue, and all other applications for Letters Patent which have been or shall be filed in the United States and in any and all foreign countries on any of said improvements, and in and to all original and reissued patents which have been or shall be issued in the United States and all foreign countries on said improvements and the right to all benefits under the International Convention for the Protection of Industrial Property.

It is hereby authorised and request that the Commissioner of Patents and Trademarks issue any and all said Letters Patent, when granted to said Assignee.

Further it is agreed that when requested, without charge to and at the expense of said Assignee, it successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all said improvements, execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known to the undersigned relating to said improvements and the history thereof; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing and maintaining proper patent protection for said improvements and for vesting title to said improvements and all applications for patents and on all patents on said improvements, in said Assignee, its successors, and legal representatives.

We covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

SIGNED at CALIFORNIA
this 15 day of February 2001

Randy Lee Gove
Randy Lee Gove

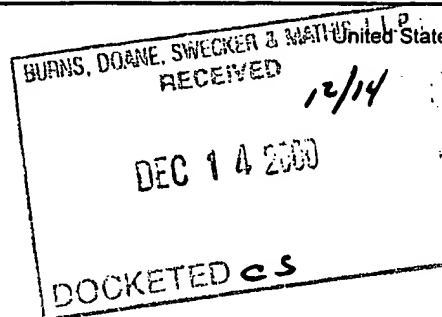
Yao Gove
Witness Signature

Name: Yao Gove

FHPMELCD\10300235.DOC - 7 February 2001 (8:21)



12 DEC 2000
UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Malcolm K. McGowan, Ph.D.
BURNS, DOANE, SWECKER & MATHIS
Post Office Box 1404
Alexandria, VA 22313-1404

In re Application of
YIP et al.
Application No.: 09/403,608
PCT No.: PCT/AU98/00868
Int. Filing Date: 18 October 1998
Priority Date: 21 October 1997
Attorney Docket No.: 025265-155
For: COATED SUNGLASS LENS

DECISION ON PETITION
UNDER 37 CFR 1.48(a)

This is a decision on "Renewed Petition Under 37 CFR 1.48(a)" filed 02 October 2000 and "Status Letter" filed 27 October 2000 requesting the addition of fifth joint inventor, Randy Lee Gove. Applicants' previous decision was dismissed in a decision dated 01 August 2000 because applicants did not submit the written consent of the assignee.

On 02 October 2000, applicant filed the present petition.

Requirements of a Petition Under 37 CFR 1.48(a)

A petition under 37 CFR 1.48(a) requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee (\$130.00) set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Requirements (1) through (3) were met with previously filed papers.

In regard to item (4) above, applicant has provided a "Consent of Assignee to Change in Inventorship Pursuant to 37 CFR 1.48(a)(4)" which states that "assignee Sola International Holdings, Ltd. hereby consents to amendments of the inventorship of the above-identified application by adding Randy Lee Gove as coinventor . . .," however, the assignee has not established its ownership to the application in accordance with 37 CFR 3.73. See Manual of Patent Examining Procedure (MPEP) §324 and the enclosed Statement under 37 CFR 3.73(b) (Form PTO/SB/96).

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

URGENT

025265-155
Sola Group
JWP/SCM/micm
Reconsideration 2/12/01
882

CONCLUSIONS

The renewed petition under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

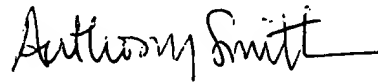
Applicant is given **TWO MONTH** from the mailing date of this decision to submit any desired request for reconsideration. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48(a)." No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

Enclosure: Form PTO/SB/96

Attorney: Brandon YIP et al.

Appln. No.: 09/403,608

Filing Date: October 25, 1999

Docket No.: 025265-155Sola

Work Atty.: Samuel C. Miller III

Date: October 27, 2000

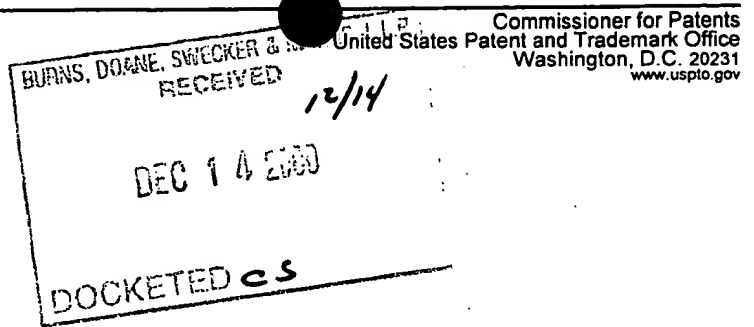
The following was/were received in the U.S. Patent and Trademark Office on the date stamped hereon:

- | | | |
|---|---|---|
| <input type="checkbox"/> Amendment or Response | <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Certificate Under 37 C.F.R. § 3.73(b) | <input type="checkbox"/> Check for \$___ is enclosed |
| <input type="checkbox"/> Preliminary Amendment | <input type="checkbox"/> Transmittal Letter for Missing Parts of Application | <input type="checkbox"/> Check for \$___ is enclosed |
| <input type="checkbox"/> Reply Transmittal Letter | <input type="checkbox"/> Executed Declaration/Power of Attorney | <input type="checkbox"/> Charge \$___ to Deposit Account |
| <input type="checkbox"/> Petition for ___ Month Extension of Time | <input type="checkbox"/> Assignment/Assignment Recordation Form Cover Sheet (PTO-1595) | <input type="checkbox"/> Issue Fee Transmittal |
| <input type="checkbox"/> Submission of Formal Drawings w/___ sheet(s) of drawings (Fig(s). 1-___) | <input type="checkbox"/> Claim for Convention Priority w/___ certified copy(s) | <input type="checkbox"/> Payment of Issue Fee and Authorization to charge Deposit Account |
| <input type="checkbox"/> Request for Approval of Drawing Changes sheet(s) of red ink drawings | <input type="checkbox"/> Information Disclosure Statement w/___ document(s) | <input type="checkbox"/> Request for Refund |
| <input type="checkbox"/> Notice of Appeal | <input type="checkbox"/> Information Disclosure Citation (PTO-1449) | <input checked="" type="checkbox"/> Status Inquiry |
| <input type="checkbox"/> Brief for Appellant | <input type="checkbox"/> Information Disclosure Statement Transmittal Letter | <input type="checkbox"/> Request for Corrected Filing Receipt w/copy of Official Filing Receipt |
| <input type="checkbox"/> Request for Oral Hearing | <input type="checkbox"/> Request for Corrected Notice of Recordation of Assignment w/copy of Notice | <input type="checkbox"/> |
| <input type="checkbox"/> Reply Brief | <input type="checkbox"/> Request for Continued Examination | <input type="checkbox"/> |
| <input type="checkbox"/> Response to Restriction Requirement or Election of Species | | |

(10/00)



12 DEC 2000
UNITED STATES PATENT AND TRADEMARK OFFICE



Malcolm K. McGowan, Ph.D.
BURNS, DOANE, SWECKER & MATHIS
Post Office Box 1404
Alexandria, VA 22313-1404

In re Application of
YIP et al.
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In regard to item (4) above, applicant has provided a "Consent of Assignee to Change in Inventorship Pursuant to 37 CFR 1.48(a)(4)" which states that "assignee Sola International Holdings, Ltd. hereby consents to amendments of the inventorship of the above-identified application by adding Randy Lee Gove as coinventor . . .," however, the assignee has not established its ownership to the application in accordance with 37 CFR 3.73. See Manual of Patent Examining Procedure (MPEP) §324 and the enclosed Statement under 37 CFR 3.73(b) (Form PTO/SB/96).

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

URGENT

025265-155
Sola Group
JWP/SCM/micm
Reg. Consideration 2/12/01
802

CONCLUSIONS

The renewed petition under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

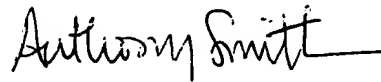
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Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

Enclosure: Form PTO/SB/96

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Brandon YIP et al.

Application No.: 09/403,608

Filed: October 25, 1999

For: COATED SUNGLASS LENS

PCT Legal Office

Leonard E. Smith

Anthony Smith

RENEWED PETITION UNDER 37 CFR 1.48(a)

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Sir:

In response to the Decision on Petition Under 37 CFR 1.48(a) issued August 1, 2000 in connection with the above-referenced application, enclosed is a written consent of assignee in compliance with 37 CFR 3.73(b), signed by David Gibson for Sola International Holdings, Ltd. This paper was indicated to be the only document missing from Applicants' previous Petition Under 37 CFR 1.48(a)(1). A copy of that petition, and the attachments thereto, is also enclosed.

Favorable reconsideration of Applicants' Petition Under 37 CFR 1.48(a)(1) is respectfully requested.

Respectfully submitted,

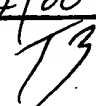
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 

Malcolm K. McGowan, Ph.D.
Registration No. 39,300

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: October 2, 2000

DOCKETED
filed 10/2/00


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Brandon YIP, *et al.*

Application No.: 09/403,608

Filed: October 25, 1999

For: COATED SUNGLASS LENS

Group Art Unit: 5071

Examiner: Unassigned

**CONSENT OF ASSIGNEE TO CHANGE IN INVENTORSHIP
PURSUANT TO 37 C.F.R. §1.48(a)(4)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Assignee Sola International Holdings, Ltd., hereby consents to amendment of the inventorship of the above-identified application by adding Randy Lee Gove as coinventor in the present application with Brandon Yip, Colin James Hall, Frank Arnold Samson, and Brian Douglas Adams.

For Sola International Holdings, Ltd.:

13 September 2000

Date



Inventor: YIP et al. 4 Filing Date: Oct. 25, 1999
Appln. No. 09/403,608 Date: April 27, 2000
Docket No.: 025265-155 Work Atty: MKM

The following was/were received in the U.S. Patent and Trademark Office on the date stamped hereon:

- ☐ Amendment or Response

☐ Preliminary Amendment

☐ Reply Transmittal Letter

☒ Petition for 2 Month Extension of Time

☐ Submission of Formal Drawings w/ sheet(s) of drawings (Fig(s). 1-)

☐ Request for Approval of Drawing Changes w/ sheet(s) of red ink drawings

☐ Notice of Appeal

☐ Brief for Appellant

☐ Request for Oral Hearing

☐ Reply Brief

☐ Response to Restriction Requirement or Election of Species

☐ Terminal Disclaimer

☐ Certificate Under 37 C.F.R. § 3.73(b)
- ☒ Transmittal Letter for Missing Parts of Application

☐ Executed Declaration/Power of Attorney

☐ Small Entity Declaration

☐ Assignment/Assignment Recordation Form Cover Sheet (PTO-1595)

☐ Claim for Convention Priority w/ certified copy(s)

☐ Information Disclosure Statement w/ document(s)

☐ Information Disclosure Citation (PTO-1449)

☐ Information Disclosure Statement Transmittal Letter

☐ Request for Corrected Notice of Recordation of Assignment w/copy of Notice
- ☒ Check for \$ 510.00 is enclosed

☐ Check for \$ is enclosed

☐ Charge \$ to Deposit Account

☐ Issue Fee Transmittal

☐ Payment of Issue Fee and Authorization to charge Deposit Account

☐ Request for Refund

☐ Status Inquiry

☐ Request for Corrected Filing Receipt w/copy of official Filing Receipt

☒ Petition to Correct Inventorship Pursuant to 37 C.F.R. §1.48(1)(1)

☒ Copy of Declaration filed Feb. 14, 2000

☐

(12/97)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Brandon YIP et al.)	Group Art Unit: 5071
Application No.: 09/403,608)	Examiner: Unassigned
Filed: October 25, 1999)	
For: COATED SUNGLASS LENS)	
)	
)	
)	

TRANSMITTAL LETTER FOR MISSING PARTS OF APPLICATION

BOX: MISSING PART
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Notice to File Missing Parts of Application Under 37 C.F.R.
§ 1.53(e) dated February 28, 2000, enclosed please find:

- ☐ a Combined Declaration and Power of Attorney signed by the inventor(s) and the surcharge of ☐ \$65.00 (205) ☐ \$130.00 (105) as set forth in 37 C.F.R. § 1.16(e);
- ☐ Note that the inventor(s) identified on the currently filed Combined Declaration and Power of Attorney are different than listed on the application filing papers.
- ☐ a Statement Claiming Small Entity Status;
- ☐ a Request for Refund;
- ☒ a Petition for Extension of Time and copy of previously filed Declaration;
- ☐ a verified English translation of the Application, and the \$130.00 (139) fee as set forth in 37 C.F.R. § 1.17(k);
- ☒ other Petition to Correct Inventorship Pursuant to 37 C.F.R. §1.48(a)(1);
- ☒ a check in the amount of \$ 510.00 for the fee due for missing parts and the Petition fee; and

4.27.02
CJP

Transmittal Letter for Missing Parts of Application

Attorney's Docket No. 025265-155

Application No. 09/403.608

Page 2

[] charge \$ _____ to Deposit Account No. 02-4800 for the fee due for missing parts.

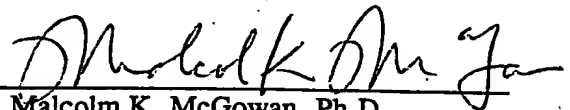
The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

By:



Malcolm K. McGowan, Ph.D.

Registration No. 39,300

Date: April 27, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
)
Brandon YIP et al.) Group Art Unit: 5071
)
Application No.: 09/403,608) Examiner: Unassigned
)
Filed: October 25, 1999)
)
For: COATED SUNGLASS LENS)

PETITION FOR EXTENSION OF TIME

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The following extension of time is requested to respond to Notification of a Defective
Response issued February 28, 2000 :

two months to May 14, 2000 ; the extension fee is:

[] \$190.00 (216) [X] \$380.00 (116).

[] The shortened statutory period has been reset by an Advisory Action dated

[X] An extension fee in the amount of \$ 380.00 is enclosed.

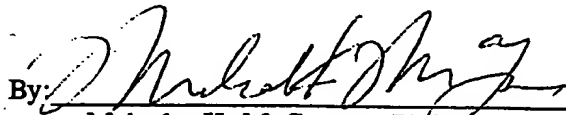
[] Charge \$ _____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

By: 
Malcolm K. McGowan, Ph.D.
Registration No. 39,300

Date: April 27, 2000

427.00
C/K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Brandon YIP, *et al.*

Application No.: 09/403,608

Filed: October 25, 1999

For: COATED SUNGLASS LENS

Group Art Unit: 5071

Examiner: Unassigned

**PETITION TO CORRECT INVENTORSHIP
PURSUANT TO 37 C.F.R. §1.48(a)(1)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant hereby petitions, pursuant to 37 C.F.R. § 1.48(a)(1), to correct the inventorship of the above-identified application. Applicant hereby requests that Randy Lee Gove be added as a coinventor in the present application. Pursuant to 37 C.F.R. § 1.48(a)(1), Applicant states that the correct inventive entity of the present application is Brandon Yip, Colin James Hall, Frank Arnold Samson, Brian Douglas Adams, and Randy Lee Gove. This petition is accompanied by a copy of the Declaration by each of the inventors as required by 37 C.F.R. §1.63; this Declaration was originally filed in this application on February 14, 2000. This petition is also accompanied by a statement of

4.27.00
CH

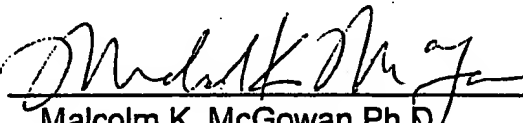
Randy Lee Gove that the error in inventorship occurred without deceptive intention on his part.

Finally, pursuant to 37 C.F.R. § 1.48(b)(2), attached hereto is the fee set forth in 37 C.F.R. § 1.17(h).

In view of the above, Applicant hereby petitions that the inventive entity be changed from Brandon Yip, Colin James Hall, Frank Arnold Samson, and Brian Douglas Adams to Brandon Yip, Colin James Hall, Frank Arnold Samson, Brian Douglas Adams, and Randy Lee Gove.

This Petition is accompanied by the fee set forth in 37 C.F.R. §1.17(i). No further fees are believed to be due by this paper. Nevertheless, the Commissioner is hereby authorized to charge any further fees under 37 C.F.R. §§1.116 and 1.117 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Malcolm K. McGowan Ph.D.
Registration No. 39,300

Post Office Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: April 28, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Brandon YIP, *et al.*

Application No.: 09/403,608

Filed: October 25, 1999

For: COATED SUNGLASS LENS

Group Art Unit: 5071

Examiner: Unassigned

DECLARATION OF RANDY LEE GOVE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Randy Lee Gove, hereby declare that the erroneous omission of my name as an inventor of the above-cited application occurred without deceptive intention.

I declare further that all statement made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 4/24/2000

By: Randy Lee Gove
Randy Lee Gove

COMBINED DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY
(Includes Reference to Provisional and PCT International Applications)

Attorney's Docket No.

025265-155

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if pl names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

COATED SUNGLASS LENS

the specification of which (check only one item below):

☒ is attached hereto.

☐ was filed as United States application

Number _____

on _____

and was amended

on _____ (if applicable).

☒ was filed as PCT international application

Number PCT/AU98/00868

on October 18, 1998

and was amended

on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119 (a)-(e) of any foreign application(s) for patent inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

PRIOR FOREIGN/PCT APPLICATION(S) AND ANY PRIORITY CLAIMS UNDER 35 U.S.C. § 119:

COUNTRY (If PCT, indicate "PCT")	APPLICATION NUMBER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 U.S.C. § 119
Australia	PO9950	21/10/1997	<u>X</u> Yes ___ No
Australia	PP8997	04/03/1999	<u>X</u> Yes ___ No
			___ Yes ___ No
			___ Yes ___ No
			___ Yes ___ No

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below

(Application Number)

(Filing Date)

(Application Number)

(Filing Date)

COMBINED DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY (CONTINUED)
(Includes Reference to Provisional and PCT International Applications)

Attorney's Docket No.
025265-155

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) or PCT international application(s) designating the United States of America that is/are listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in that/those prior application(s) in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations §1.56, which became available between the filing date of the application(s) and the national or PCT international filing date of this application:

PRIOR U.S. APPLICATIONS OR PCT INTERNATIONAL APPLICATIONS DESIGNATING THE U.S. FOR BENEFIT UNDER 35 U.S.C. 120:

U.S. APPLICATIONS		STATUS (check one)		
U.S. APPLICATION NUMBER	U.S. FILING DATE	PATENTED	PENDING	ABANDONED
PCT APPLICATIONS DESIGNATING THE U.S.				
PCT APPLICATION NO.	PCT FILING DATE	U.S. APPLICATION NUMBERS ASSIGNED (if any)		

I hereby appoint the following attorneys and agent(s) to prosecute said application and to transact all business in the Patent and Trademark Office connected therewith and to file, prosecute and to transact all business in connection with international applications directed to said invention:

William L. Mathis	17,337	R. Danny Huntington	27,903	Gerald F. Swiss	30,113
Robert S. Swecker	19,885	Eric H. Weisblatt	30,505	Michael J. Ure	33,089
Platon N. Mandros	22,124	James W. Peterson	26,057	Charles F. Wieland III	33,096
Benton S. Duffett, Jr.	22,030	Teresa Stanek Rea	30,427	Bruce T. Wieder	33,815
Norman H. Stepno	22,716	Robert E. Krebs	25,885	Todd R. Walters	34,040
Ronald L. Grudziecki	24,970	William C. Rowland	30,888	Ronni S. Jillions	31,979
Frederick G. Michaud, Jr.	26,003	T. Gene Dillahunty	25,423	Harold R. Brown III	36,341
Alan E. Kopecki	25,813	Patrick C. Keane	32,858	Allen R. Baum	36,086
Regis E. Slutter	26,999	Bruce J. Boggs, Jr.	32,344	Steven M. du Bois	35,023
Samuel C. Miller, III	27,360	William H. Benz	25,952	Brian P. O'Shaughnessy	32,747
Robert G. Mukai	28,531	Peter K. Skiff	31,917		
George A. Hovanec, Jr.	28,223	Richard J. McGrath	29,195		
James A. LaBarre	28,632	Matthew L. Schneider	32,814		
E. Joseph Gess	28,510	Michael G. Savage	32,596		



21839

and: Malcolm K. McGowan, Ph.D., Reg. No. 39,300

Address all correspondence to:



21839

Samuel C. Miller, III
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, Virginia 22313-1404

Address all telephone calls to: Samuel C. Miller, III, Reg. No. 27,360 at (703) 836-662

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and those like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

COMBINED DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY (CONTINUED)
(Includes Reference to Provisional and PCT International Applications)

Attorney's Docket No

025265-155

FULL NAME OF SOLE OR FIRST INVENTOR

Brandon YIP

SIGNATURE

X Brandon Yip

DATE

X 29/11/19

RESIDENCE

Unit 3, 4 Stirling Road, Blackwood, South Australia 5051, AUSTRALIA

CITIZENSHIP

POST OFFICE ADDRESS

Unit 3, 4 Stirling Road, Blackwood, South Australia 5051, AUSTRALIA

FULL NAME OF SECOND JOINT INVENTOR, IF ANY

Colin James HALL

SIGNATURE

X Colin Hall

DATE

X 11/12/19

RESIDENCE

Unit 2, 8 Hillview Crescent, South Brighton, South Australia 5048 AUSTRALIA

CITIZENSHIP

POST OFFICE ADDRESS

Unit 2, 8 Hillview Crescent, South Brighton, South Australia 5048 AUSTRALIA

FULL NAME OF THIRD JOINT INVENTOR, IF ANY

Frank Arnold SAMSON

SIGNATURE

X Frank Samson

DATE

X 13/12/19

RESIDENCE

2632 Cosgrove Road, Strathalbyn, South Australia 5255, AUSTRALIA

CITIZENSHIP

POST OFFICE ADDRESS

2632 Cosgrove Road, Strathalbyn, South Australia 5255, AUSTRALIA

FULL NAME OF FOURTH JOINT INVENTOR, IF ANY

Brian Douglas ADAMS

SIGNATURE

X B. Adams

DATE

X 29/11/19

RESIDENCE

39 Darwendale Street, Huntfield Heights, South Australia 5163, AUSTRALIA

CITIZENSHIP

POST OFFICE ADDRESS

39 Darwendale Street, Huntfield Heights, South Australia 5163, AUSTRALIA

FULL NAME OF FIFTH JOINT INVENTOR, IF ANY

Randy Lee GOVE

SIGNATURE

X Randy Gove

DATE

X 12/17/19

RESIDENCE

1202 Maple Drive, Rohnert Park, CA 94928, U.S.A.

CITIZENSHIP

POST OFFICE ADDRESS

1202 Maple Drive, Rohnert Park, CA 94928, U.S.A.

FULL NAME OF SIXTH JOINT INVENTOR, IF ANY

SIGNATURE

DATE

RESIDENCE

CITIZENSHIP

POST OFFICE ADDRESS

FULL NAME OF SEVENTH JOINT INVENTOR, IF ANY

SIGNATURE

DATE

RESIDENCE

CITIZENSHIP

POST OFFICE ADDRESS

FULL NAME OF EIGHTH JOINT INVENTOR, IF ANY

SIGNATURE

DATE

RESIDENCE

CITIZENSHIP

POST OFFICE ADDRESS

FULL NAME OF NINTH JOINT INVENTOR, IF ANY

SIGNATURE

DATE

RESIDENCE

CITIZENSHIP

POST OFFICE ADDRESS

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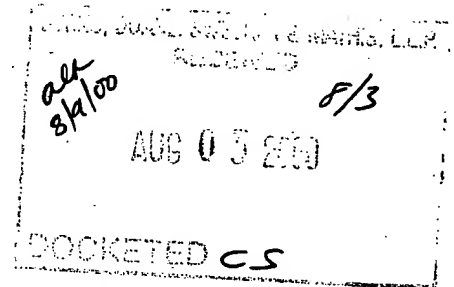


UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Malcolm K. McGowan, Ph.D.
BURNS, DOANE, SWECKER & MATHIS
Post Office Box 1404
Alexandria, VA 22313-1404



In re Application of
YIP et al.
Application No.: 09/403,608
PCT No.: PCT/AU98/00868
Int. Filing Date: 18 October 1998
Priority Date: 21 October 1997
Attorney Docket No.: 025265-155
For: COATED SUNGLASS LENS

:
:
:
: DECISION ON PETITION

:
: UNDER 37 CFR 1.48(a)
:
:

This is in response to applicants' "PETITION TO CORRECT INVENTORSHIP PURSUANT TO 37 CFR 1.48(a)(1)" filed 27 April 2000. The required fee of \$130 under 37 CFR 1.17(i) has been submitted.

BACKGROUND

On 18 October 1998, applicants filed international application No. PCT/AU98/00868 which claimed a priority date of 21 October 1997. The international application named Brandon Yip, Colin James Hall, Frank Samson, and Brian Douglas Adams as inventors. A copy of international application was communicated to the United States Patent and Trademark Office from the International Bureau on 29 April 1999. A Demand for international preliminary examination was filed on 23 March 1999, prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 21 April 2000.

On 25 October 1999, applicants filed a Transmittal Letter (Form PTO-1390) for entry into the national stage accompanied by, *inter alia*, the requisite basic national fee, a copy of the international application, and a first preliminary amendment.

URGENT

025265-155
Solo Group
JWP/SCM/MKM
8/2
Reg. Reconsideration Due 10/1/00

On 14 December 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was not executed in accordance with 37 CFR 1.66 or 1.68.

On 14 February 2000, applicant filed "Transmittal Letter for Missing Parts of Application" accompanied by, inter alia: a petition for a one-month extension of time; oath and declaration surcharge under 37 CFR 1.492(e); and a declaration executed by Brandon Yip, Colin James Hall, Frank Samson, Brian Douglas Adams, and Randy Lee Gove.

On 28 February 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was defective because the fifth inventor (Randy Lee Gove) was not listed on the published international application.

On 27 April 2000, applicants filed a "Petition to Correct Inventorship Pursuant to 37 CFR 1.48(a)(1)," which was accompanied by a petition for a one-month extension of time and a declaration of Randy Lee Gove.

DISCUSSION

In the instant case, the international application named Brandon Yip, Colin James Hall, Frank Samson, and Brian Douglas Adams as inventors. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a petition under 37 CFR 1.48(a) is required.

A petition under 37 CFR 1.48(a) to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicants have satisfied items (1), (2) and (3). In order to satisfy item (4), applicants are required to submit a written consent of assignee to the correction in inventorship in compliance

with 37 CFR 3.73(b), if the instant application has been assigned, or, in the alternative, a statement that the application has not been assigned.

CONCLUSION

For the reasons discussed above, applicants' petition under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

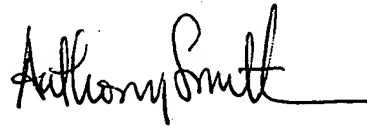
If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48(a)." No additional petition fee is required.

A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b), if the instant application has been assigned, or, in the alternative, a statement that the application has not been assigned.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard E. Smith
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Tel.: (703) 308-6314
Fax.: (703) 308-6459